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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/925,826 | 08/09/2001 | Yuri Kazakevich | 00167-428001 | 4667 |

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SMITH & NEPHEW, INC
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EXAMINER

MULCAHY, JOHN M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 12/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,826

Applicant(s)

KAZAKEVICH, YURI

Examiner

John M. Mulcahy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11 and 13-26 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11. 6) ☐ Other: _____

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- a. Claims 1, 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Thompson (6,007,484).

Hoeg et al. clearly shows the endoscope substantially as claimed (see Fig. 15 and its description), but fails to show the imaging probe including a light source. However, Thompson shows an analogous endoscope having a pivoting and rotating imaging probe 15 including a light source 13. It would have been obvious to the artisan to modify Hoeg et al. by adding a light source to the pivoting and rotating imaging probe, since Thompson teaches that such will provide illumination of the area at which the imager is pointed. See col. 2, lines 59-64.

- b. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Thompson (6,007,484) as applied to claim 1 above, further in view of the Examiner's official notice.

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Hoeg et al. fails to show a chain and sprocket. However, the Examiner takes official notice that it was notoriously old and well known to use a chain and sprocket for analogous purpose. Inasmuch as Hoeg et al. specifies a mechanical linkage (col. 10, lines 29-36), it would have been obvious to the artisan to modify Hoeg et al. by using a chain and sprocket in place of the mechanical linkages disclosed since the artisan would expect such to work equally as well.

c. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Thompson (6,007,484) as applied to claim 1 above, further in view of Klieman et al. (5,827,323).

Hoeg et al. fails to show a push rod and rack and pinion. However, Klieman et al. shows an analogous endoscope utilizing such an arrangement (see Figs. 2, 10 and 11). Inasmuch as Hoeg et al. specifies a mechanical linkage (col. 10, lines 29-36), it would have been obvious to the artisan to modify Hoeg et al. by using a push rod and rack and pinion as taught by Klieman et al. in place of the mechanical linkages disclosed since the artisan would expect such to work equally as well.

d. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Thompson (6,007,484) as applied to claim 1 above, further in view of the Examiner's official notice.

Hoeg et al. fails to show fluid or air ports. However, the Examiner takes official notice that it was notoriously old and well known to provide such fluid and air ports on analogous endoscopes. It would have been obvious to the artisan to modify Hoeg et al. by adding such ports since such would allow the objective lens to be cleaned *in situ*.

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e. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoeg et al. (6,371,909) in view of Thompson (6,007,484) as applied to claim 1 above, further in view of Wilk et al. (WO 93/15648).

Hoeg et al. fails to show a transmitter. However, Wilk et al. teach an analogous endoscope having a transmitter 156 and power source 158. It would have been obvious to the artisan to modify Hoeg et al. by adding such a transmitter, etc., since Wilk et al. teach such to be advantageous.


Allowable Subject Matter

3. Claims 10, 11, 13, 14 and 16-26 are allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.


John M. Mulcahy
Primary Examiner
Art Unit 3739

John Mulcahy
December 9, 2003